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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/643,948 08/23/00 YASUFUKU

K 2423-6

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MM91/0713

EXAMINER

FIGUEROA, F

ART UNIT

PAPER NUMBER

2833

DATE MAILED: 07/13/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/643,948

Applicant(s)

YASUFUKU ET AL.

Examiner

Felix O. Figueroa

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 23 May 2001 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

Claims 1 and 20 are objected to because of the following informalities: In lines 3 of each, "the board plane" should be --a board plane--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1 and 20 lines 9 of each, "the face and back" lacks of antecedent basis in the claims. Is this limitation intended to "a top face and a bottom face?"

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 9, 14 and 15 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Tondreault (US 5,769,668) in view of Hopfer et al. (US 5,761,036).

Tondreault discloses a connector body (10) having a receiving part (14) having a contacts (20) provided in a groove that contact the conductive pad on top and bottom

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surfaces (the face and back) of the a module, a supporting part (24,26) which extends rearward from the receiving part, and a positioning mechanism (28,30) to hold a module in a forward-rearward direction. However Tondreault does not disclose a metallic cover which engages with the connector body to sandwich a module inbetween. Hopfer teaches the use of a hinged, removable, metallic cover, to keep a module in place. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use a cover, as taught by Hopfer, to keep the module from moving from the connecting position.

Claims 5, 6, 10, 11, 16, 17 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tondreault and Hopfer et al. as applied to claims 4, 9 and 15 above, and further in view of Scheingold et al. (US 3,877,064).

Scheingold teaches the use of a cover (28) having a window (19) and a heat sink (68) in the window covering a conductive member (62) to dissipate the heat from the conductive member. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use a heat sink covering a conductive member, as taught by Scheingold, to perform a heat dissipation function.

Claims 7, 8, 12, 13, 18 and 19 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Tondreault and Hopfer et al. as applied to claims 4, 9 and 15 above, and further in view of Buller et al. (US 4,978,638).

Buller teaches the use of a contacting part (14) to transfer the thermal energy to a heat sink. It would have been obvious to a person having ordinary skill in the art at

the time the invention was made to use a contacting part, as taught by Buller, to transfer the thermal energy to the heat sink.

Response to Arguments

Applicant's arguments filed 05/23/01 have been fully considered but they are not persuasive.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Hopfer clearly states the use of a metallic cover (16) sandwiching a module between the cover and the supporting part to retain the module in the connecting position. Apparently, applicant is misinterpreting the requirement of a teaching or motivation to combine or modify the prior art, found in the reference themselves (for instance Hopfer) or in the knowledge of a skill artisan, by requiring a statement of a deficiency in the prior art (for instance Tondreault). Applicant is reminded that a statement of a deficiency in the prior art (for instance Tondreault) is not required in order to modify and/or improve upon it. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use a cover in the connector of Tondreault, as taught by Hopfer, to keep the module from moving from the connecting position. Additionally, the

fact that a modification would be redundant does not render the modification non-obvious. Furthermore, in numerous cases, redundancy is an expected and required feature.

In response to applicant's argument that the references (for instance Scheingold) fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the heat sink been structurally interconnected to the cover) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument that the references do not teach the metallic cover and the heat sink to exhibit a shielding function against electromagnetic waves, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Felix O. Figueroa whose telephone number is (703) 308-0097. The examiner can normally be reached on Mon.-Fri., 8:00-5:00.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1782.

ffr
July 11, 2001


RENEE LUEBKE
PRIMARY EXAMINER